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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,346	09/11/2003	Keith Park	P06430US00	5112
22885	7590	08/25/2005	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			SELF, SHELLEY M	
			ART UNIT	PAPER NUMBER
			3725	
DATE MAILED: 08/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/660,346	PARK ET AL.
	Examiner	Art Unit
	Shelley Self	3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 June 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4,6-8,10-19 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,5,9 and 20-24 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4,6-8,10,11, 17-19 and 25-27 is/are rejected.
- 7) Claim(s) 12-14 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 September 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 1/29/04.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of the invention of Species I, figures 1-7 in the reply filed on June 13, 2005 is acknowledged. However, Applicants response is not fully understood. Applicant notes that claims 1, 17 and 20 are generic and that claims 1, 4, 6-20 and 25-27 are readable on the species of Figures 1-7, however claims 19 and 20, independent claims are not generic. For example, claim 19 is readable only on the species of figure 7b and claim 20 is readable only on the species of figures 8 and 9, i.e., a non-elected species. Claim 9 appears to be readable on the species of figures 8 and 9 as noted by the clear recitation of a movable passage (line 1); this limitation is not generic and not germane to the species of figures 1-7. Further claims 17, 19 and 20 are clearly readable on two separate and distinct species as denoted by figures 7a, 7b and 8. Claims 25-27 refer back to and are dependent on both elected and non-elected claims. Claims 9 and 20 are not deemed to be readable on the species of figures 1-7 and accordingly have not been further treated on the merits.

Claims 2, 3, 5, 9 and 20-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 13, 2005.

The restriction requirement is made FINAL.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are unclear due to poor spacing, lead lines, and legibility.

Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "10" has been used to designate both *direction* (7, line 6) and *planer* (pg. 11, line 8). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *motor* (clm. 4) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. (Examiner notes, Applicant elected the invention of species I, figures 1-7, wherein the motor is not illustrated; the motor is only illustrated in the species of figures 8-9 of which were not elected without traverse in a response filed June 13, 2005).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 39, 41. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The

corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

- Pg. 3, line 8, following the work “opening” delete **–and–**
- Pg. 9, line 13, “mace” should be **–made—**
- Pg. 10, line 8, following the word front “o” should be **–of—**
- Pg. 11, line 13, following the work instead, “f” should be **–of—**
- Clm 12, line 5, “pass age” should be **–passage-**

Appropriate correction is required.

Claims 15, 16 and 25-27 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may not serve as a basis for another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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Claims 1, 4, 6-8, 10-14, 17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 17 and 19, the word "means" is preceded by the word(s) "drive" and in claims 11 and 14, the word "means" is preceded by the word(s) "user selection" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). It is unclear if Applicant is invoking 35 U.S.C. 112 6th paragraph. Clarification is required. Examiner suggests, --means for driving..., means for selecting...--

The following do not have sufficient antecedent bases:

"the motor" (clm. 4)

"the workpiece" (clm. 6)

"the stream" (clm. 6); Examiner suggests, --a stream—

"the high speed" (clm. 6); Examiner suggest, --a high speed—

"the housing" (clm. 7)

"the draft" (clm. 8); Examiner suggest, --a draft--

With regard to claims 6-8, the terms, blade cylinder and cylinder are used interchangeably. For example, claim 6, states, "the blade cylinder is rotatably...", claim 8 states, "...the cylinder rotation...", it is unclear if blade cylinder and cylinder refer to the same element/limitation. Examiner suggests use of one term or the other for consistency and clarity.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4 and 6-8 as best as can be understood are rejected under 35 U.S.C. 102(b) as being anticipated by Casal (5,024,000). Casal discloses a power planer tool (fig. 1), said planer tool having a cylinder (5) with at least one cutter blade (6, 7) mounted thereon (figs. 4-6) a drive means to cause the cylinder to rotate about an axis of rotation with a portion of the cylinder exposed through an opening in a planning surface of the planer to case the removal material from a surface along which the planning surface is moved (fig. 1, 2, 4-6); said cylinder and drive means mounted within a housing (1) and wherein the drive means is positioned in the housing above the axis of rotation of cylinder (col. 2, lines 16-18).

With regard to claim 4 as best as can be understood, Casal discloses the weight of motor is above the cutting blades (figs. 4, 5).

With regard to claim 6, as best as can be understood, Casal discloses a cylinder (5) with a cutter blade (6,7) rotatably mounted with a blade chamber (fig. 5, 6), the blade chamber being a void space into which chips or shaving from a workpiece are drawn by a stream of air created by a high speed rotation of the cylinder (5).

With regard to claims 7 and 8, as best as can be understood, Casal discloses a housing (fig. 1) of the planer includes a chip and debris removal system (19, 20), said system including at least one channel which passes from an opening at or adjacent to the blade chamber in which the

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cylinder (5) is located to at least one further opening (19) to allow the chips and debris to exit towards the rear of the housing (col. 2, lines 49-56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 11, as best as can be understood is rejected under 35 U.S.C. 103(a) as being unpatentable over Casal (5,024,000) in view of Hild et al. (5,383,275). Casal does not disclose at least two passages. Hild teaches in a closely related art a planer having a housing (3), rotatable cylinder (13) with a plurality of blades (fig. 1) driven by a motor (9) for removing a material from a surface of a workpiece. Hild also teaches the use of at least one channel (15) leading to at least two passages (21, 23) having openings (31, 33) on either side of the housing wherein means for selecting (25, 35; col. 3, lines 60-68 to col. 4, lines 1-13) the passage are incorporated for directing the chip/debris through either passage opening (31, 33). Hild teaches this construction so as to be able to efficiently eject chips/debris/shavings from the planer and prohibit clogging of such debris within the planer. Because the references are from a similar art, and deal with a similar problem (i.e., chip removal) it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Casal's chip/debris removal/ejection system with one incorporating at least one channel and at least two passages having an opening so as to efficiently removal chip/shavings from the planer as taught by Hild.

Claims 17-19, as best as can be understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Casal (5,024,000) in view of Hu (6,367,523). With regard to claims 17-19, As noted above, Casal discloses a planer tool comprising a cylinder (5) having two blades (6,7) mounted thereon at least 120 degrees or less apart (figs. 4-6); a means for driving the cylinder (2) Casal does not disclose a cylinder with more than two straight cutting blades or two or more helical shaped blades.

It would have been obvious at the time of the invention to one having ordinary skill in the art to provide Casal with more than two straight blades because mere duplication of essential working parts of a device involves only routine skill in the art. See *St. Regis Paper co. v. Bemis Co.*, 193, USPQ 8.

Moreover, Hu teaches in a closely related art a rotatable cylinder planning cutter having at least three blades wherein it is admitted prior art to construct a cylinder of more than two straight blades (figs. 1, 2). Additionally, Hu teaches the use of a cylinder with helical mounted blades (fig. 3) wherein the blades are 180 degrees or less apart around the periphery of the cylinder. Hu teaches the use of helically mounted blades as opposed to the admitted prior art straight/linear blade so as to reduce frictional resistance on the cutting edge of the blade and thus reduce energy consumption of motor powering to the cylinder (col. 1, lines 45-53). Accordingly, it would have been obvious at the time of the invention to replace Casal with more than two straight blades or with helical blades as taught by Hu so as to efficiently plane a work surface.

As to one rotation of the cylinder at least three different blades contact the surface to be planed (clm. 18), Hu teaches at least three blades thus each different blade will contact the surface during one revolution of the rotary cylinder.

Allowable Subject Matter

Claims 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose or fairly suggest a planar comprising *two channels from the blade chamber, each channel leading to a passage each passage having an opening in combination with the rest of the claimed limitations as set forth in claim 12.*

As noted above, the prior art reference Casal discloses a hand operated powered planar having a single channel and passage including an opening (19) for discharging chips and shavings or debris resulting from the rotary cutting of the planer cutter (5). Casal does not disclose two channels or two passages. Accordingly, Casal fails to anticipate or render obvious the claimed invention as set forth in claim 12.

Additionally, prior art reference, Hild et al. (hereinafter referred to as Hild) discloses a hand operated powered planer having two passages associated with a single channel for discharging chips and debris from the planer. Although Hild discloses two passages having openings (31, 33) for discharging debris, Hild does not disclose more than one channel, and thus fails to anticipate or render obvious the claimed invention as set forth in claim 12.

Accordingly, neither the prior art of record nor any combination thereof discloses the claimed invention. Thus claim 12 contains allowable subject matter over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S Self
August 18, 2005



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